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| EXAMINER | |
|---|---|
| KE, PENG | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/830,224 | BANKS ET AL. | |
| | Examiner | Art Unit | |
| | SIMON KE | 2174 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *17 December 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-3,5,7-15,18-22 and 29-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3, 5, 7-15, 18-22, and 29-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/17/08 has been entered.

Claims 1-3, 5, 6-15, and 18-32 are pending in this application. Claims 1, 13, and 23 are independent claims. In the amendment filed on 12/17/08, claims 1, 8, 13, and 23 were amended.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter.

Claims 1-3, 5, 7-15, 18-22, and 29-32 are reciting a non-statutory method because its process does not tie to another statutory class or transform underlying subject matter to a different state or thing.

Claim 23-28 are reciting a non-statutory medium because the readable medium recited in the claims includes a communication medium which may be interpreted as signal or carrier waves, which are non-statutory subject matter.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3,5, 7-15, and 18-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ermel et al. ("Ermel" US Patent No. 5,835,094) in view of Edelman ("Edelman" US Patent No. 5,680,563) and Mander et al. ("Mander" US Patent No. 6,243,724) further in view Rosenzweig (US Patent 6,950,989)

Regarding independent claim 1, Ermel teaches a method for representing files stored in stacks, the method comprising:

receiving an identification of a plurality of files to be represented by a stack icon (i.e. items 20, 20a and 20b in Figs. 1-6 et seq. of Ermel).

Determining a stack for each of stock icons, wherein a stock icon corresponds to the each of individual files that are represented by the stack icon. (i.e. items 20, 20a and 20b in Figs. 1-6 et seq. of Ermel).

Dividing the stack icons to fractions. (i.e. items 20, 20a and 20b in Figs. 1-6 et seq. of Ermel).

Displaying each stack icon's assigned predefined stack icon as representation of the stack icon. (i.e. items 20, 20a and 20b in Figs. 1-6 et seq. of Ermel).

However, Ermel fails to teach the plurality of stack sizes comprise a range, wherein differ from all other predefined icons and is proportional to medium stack relative position in the range;

Mander teaches comparing the stack size within range; identifying one of the sub-ranges into which the determined stack falls; retrieving the stack icon that has been assigned to the

identified stack. (i.e. "create and display pile" step of FIG. 19 et seq. of Mander; see also steps 955 and 963 in FIG. 20 et seq. of Mander). It would have been obvious to an artisan at the time of the invention to combine the stack icons based on size of Mander with the stack icons of Ermel and the identification of files and libraries of Edelman to generate a "sorted list" which "corresponds to a sorted list of documents" (col. 34 line 13 et seq. of Mander)

However, Ermel, and Mander fail to teach dividing the stack icons based on size into equal fractions, wherein a largest stack size fraction comprising largest stack size, one or more medium stack size fraction comprising medium stack sizes, and smallest stack size fraction comprising smallest stack sizes; assigning each of the stack icon in the largest stack size fraction a predefined largest stack icon; assigning each of the stack icon in the smallest a stack size fraction a predefined smallest stack icon, and assigning each of the one ore more medium stack size fraction a predefined medium stack icon, wherein if stack icons have been divided into more than one medium stack size fraction, each medium stack size fraction of the plurality medium stack size assigned a predefined medium stack icon.

Rosenzweig (US Patent 6,950,989) teaches dividing the stack icons based on size into equal fractions, wherein a largest stack size fraction comprising largest stack size, one or more medium stack size fraction comprising medium stack sizes, and smallest stack size fraction comprising smallest stack sizes; assigning each of the stack icon in the largest stack size fraction a predefined largest stack icon; assigning each of the stack icon in the smallest a stack size fraction a predefined smallest stack icon, and assigning each of the one ore more medium stack size fraction a predefined medium stack icon, wherein if stack icons have been divided into more

than one medium stack size fraction, each medium stack size fraction of the plurality medium stack size assigned a predefined medium stack icon. (see Rosenzwig col.3, lines 45-lines 65)

It would have been obvious to an artisan at the time of the invention to combine Rosenzweig's teaching with the stack icons of Ermel and Mander to provide user with the option to control the appearance and behavior of desktop objects.

Regarding dependent claim 2, see the analysis of claim 1 above. Where in the equal fraction comprise equal thirds and wherein the method comprises

Dividing the stack icons based on size into largest third, a medium third and a smallest third; assigning each of the stack icon in the largest third a predefined largest stack icon; assigning each of the stack icons in the medium third a predefined medium stack icon; and assigning each of the stack icons in the smallest third a predefined smallest stack icon (see Rosenzwig col.3, lines 45-lines 65)

Regarding dependent claim 3, see the analysis of claim 2 above. Ermel, in combination with Mander, and Rosenzweig teaches the method of claim 2, further comprising storing an empty stack icon that displays an image distinct from other icons in the plurality of predefined stack icons (col. 9 line 40 et seq. of Mander : "the filing system may provide the user with an empty base for placing documents thereon to create a new pile"; see also empty slot created in Figs. 5-6 et seq. of Ermel ).

Regarding dependent claim 5, see the analysis of claim 4 above. Ermel, in combination with Mander, and Ulrich teaches the method of claim 4, further comprising the steps of

identifying one of said icons as a maximum range identified by a minimum size, and the identifying one of the sub-ranges includes determine whether the determined stack size exceeds said size minimum (i.e. number of subpiles from piles determined in FIG. 18b et seq. of Mander).

Regarding dependent claim 7, see the analysis of claim 5 above. Ermel, in combination with Mander, and Rosenzweig teaches the method of claim 5, further comprising selecting the empty stack icon if the stack is empty in the retrieving of predetermined stack icon if the determined stack size is zero (col. 9 line 40 et seq. of Mander : "the filing system may provide the user with an empty base for placing documents thereon to create a new pile"; see also empty slot created in Figs. 5-6 et seq. of Ermel ).

Regarding dependent claim 8, see the analysis of claim 1 above. Ermel, in combination with Mander, and Rosenzweig teaches the method of claim 1, further comprising generating different stack icons to represent files in different distinct libraries, wherein each of said stack icons displays information corresponding to a distinct library (i.e. FIG. 13b, 22d et seq. of Mander).

Regarding dependent claim 9, see the analysis of claim 1 above. Ermel, in combination with Mander, and Rosenzweig teaches the method of claim 1 wherein said the retrieved stack icon visually identifies a file type of the plurality of files (i.e. FIG. 13b, 22d et seq. of Mander).

Regarding dependent claim 10, see the analysis of claim 9 above. Ermel, in combination with Edelman Mander, and Rosenzweig teaches the method of claim 9, wherein the visual identification of file type is a persistent overlay on the icon (i.e. FIGS. 4e, 12a and 12b et seq. of Mander; see also "Doc2" overlay in Figs. 5 and 6 of Ermel).

Regarding dependent claim 11, see the analysis of claim 1 above. Ermel, in combination with Mander, and Ulrich teaches the method of claim 1, wherein said retrieved stack icon includes a thumbnail image displaying contents of one of the plurality of files (i.e. FIG. 22e et seq. of Mander).

Regarding dependent claim 12, see the analysis of claim 1 above. Ermel, in combination with Mander, and Rosenzweig teaches a computer readable medium storing the computer executable instructions for performing the method of claim 1 (i.e. claim 17 et seq. of Edelman : "computer usable medium").

Regarding independent claim 13, it is rejected under the same rationale as claim 1. Supra.

Regarding dependent claim 14, see the analysis of claim 13 above. Ermel, in combination with Mander, and Rosenzweig teaches the method of claim 13; wherein said information associated with said library identifies said common type of said library (i.e. FIG. 13b, 22d et seq. of Mander).

Regarding dependent claim 15, see the analysis of claim 13 above. Ermel, in combination with Mander, and Rosenzweig teaches the method of claim 13, further comprising generating a unique empty stack icon representing a stack having no files (col. 9 line 40 et seq. of Mander : "the filing system may provide the user with an empty base for placing documents thereon to create a new pile"; see also empty slot created in Figs. 5-6 et seq. of Ermel ).

Regarding dependent claim 18, see the analysis of claim 13 above. Ermel, in combination with Mander, and Rosenzweig teaches the method of claim 13, wherein said stack height depicts two items when said plurality of files contains more than two files (i.e. col. 7 line 35 et seq. of

Mander : "The dynamic graphical representation of a pile increases in height when a document is added to the pile and decreases in height when a document is removed from the pile" ).

Regarding dependent claim 19, see the analysis of claim 15 above. Ermel, in combination with Mander, and Rosenzweig teaches the method of claim 15, further comprising selecting the empty stack icon in response to a user request to display a stack having no files (col. 9 line 40 et seq. of Mander : "the filing system may provide the user with an empty base for placing documents thereon to create a new pile"; see also empty slot created in Figs. 5-6 et seq. of Ermel ).

Regarding dependent claim 20, see the analysis of claim 13 above. Ermel, in combination with Mander, and Rosenzweig teaches the method of claim 13, further comprising the step of adding an overlay to said generated icon, said overlay identifying a property of the files represented by the generated icon (i.e. FIGS. 4e, 12a and 12b et seq. of Mander; see also "Doc2" overlay in Figs. 5 and 6 of Ermel).

Regarding dependent claim 21, see the analysis of claim 13 above. Ermel, in combination with Mander, and Rosenzweig teaches the method of claim 13, wherein said step of generating further includes the step of including a thumbnail in said stack icon said thumbnail depicting contents of one of said plurality of files (i.e. FIG. 22e et seq. of Mander).

Regarding dependent claim 22, see the analysis of claim 13 above. Ermel, in combination with Mander, and Rosenzweig teaches a computer readable medium storing the computer executable instructions for performing the method of claim 13 (i.e. claim 17 et seq. of Edelman : "computer usable medium").

Regarding independent claim 23, Ermel teaches a system for representing a selected stack of files, the system comprising: one or more computer-readable media storing sets of default stack icons, wherein each stored set of default stack icons includes multiple icons, one or more computer-readable media storing computer-executable instructions for generating one or more icon selection tools having a corresponding stored set of default icons, the icon selection tools select and display corresponding icon from said corresponding set of default icons (i.e. items 20, 20a and 20b in Figs. 1-6 et seq. of Ermel). Ermel does not teach identification of files and libraries or determining and generating stack icons based on files stack size.

Mander teaches identification of files and libraries (i.e. FIG. 13b, 22d et seq. of Mander).

Mander teaches determining a stack size of a selected plurality of files; comparing the stack size to a plurality of stack size that divide a stack size range (i.e. "create and display pile" step of FIG. 19 et seq. of Mander; see also steps 955 and 963 in FIG. 20 et seq. of Mander).

Displaying the default stack icon with a common property overlay, wherein the common property overlay comprises an additional icon indicating a common property of all files in the plurality of files and wherein the common property overlay is display within the boundaries of the default stack icon. (i.e. FIG. 13b, 22d et seq. of Mander

It would have been obvious to an artisan at the time of the invention to combine the stack icons based on size of Mander with the stack icons of Ermel and the identification of files and libraries of Edelman to generate a "sorted list" which "corresponds to a sorted list of documents." (col. 34 line 13 et seq. of Mander)

However, Ermel, and Mander fail to teach predefined range of stack icon, wherein said range is subdivided into at least three stack size sub-ranges and wherein the stack size corresponds to the number of individual files that form the plurality of files.

Rosenzweig (US Patent 6,950,989) teaches predefined range of stack icon, wherein said range is subdivided into at least three stack size sub-ranges and wherein the stack size corresponds to the number of individual files that form the plurality of files. (col.3, lines 45-lines 65)

It would have been obvious to an artisan at the time of the invention to combine Rosenzweig's teaching with the stack icons of Ermel, and Mander to provide user with the option to control the appearance and behavior of desktop objects.

Regarding dependent claim 24, see the analysis of claim 23 above. Ermel, in combination with Mander, and Rosenzweig teaches the system of claim 23, wherein each stored set of default icons comprises a plurality of stack icons, each icon corresponding to a different range of stack sizes (i.e. col. 7 line 35 et seq. of Mander : "The dynamic graphical representation of a pile increases in height when a document is added to the pile and decreases in height when a document is removed from the pile" ).

Regarding dependent claim 25, see the analysis of claim 24 above. Ermel, in combination with Mander, and Rosenzweig teaches the system of claim 24, said plurality of stack icons further comprising a unique empty stack icon that displays a distinct image (col. 9 line 40 et seq. of Mander : "the filing system may provide the user with an empty base for placing documents thereon to create a new pile"; see also empty slot created in Figs. 5-6 et seq. of Ermel ).

Regarding dependent claim 26, see the analysis of claim 23 above. Ermel, in combination with Mander, and Rosenzweig teaches the system of claim 23, said first one or more computer-readable media further storing a set of property based icons for at least one library, wherein the property based icons include an overlay indicating a common property of files represented by an underly stack icon. (i.e. figure 13b, items 575, 578, 576, and 577, FIGS. 4e, 12a and 12b et seq. of Mander; see also "Doc2" overlay in Figs. 5 and 6 of Ermel).

Regarding dependent claim 27, see the analysis of claim 23 above. Ermel, in combination with Mander, and Rosenzweig teaches the system of claim 23, said computer-executable instructions further comprising instructions for generating a set of custom thumbnail icons for at least one selected library, wherein the custom thumbnail icons include at least one image from a stack within the at least one selected library (i.e. FIG. 22e et seq. of Mander).

Regarding dependent claim 28, see the analysis of claim 23 above. Ermel, in combination with Mander, and Rosenzweig teaches the system of claim 23, said computer-executable instructions further comprising instructions for counting the number of files in a selected stack and displaying the number adjacent to or on the icon (i.e. FIG. 8 of Edelman).

Regarding dependent claim 29, see the analysis of claim 10 above. Mander, in combination with Ermel, and Rosenzweig teaches the system of claim 10, wherein said overlay is a symbol provided by application that owns the file type. (i.e. figure 13b, items 575, 578, 576, and 577, FIGS. 4e, 12a and 12b et seq. of Mander; see also "Doc2" overlay in Figs. 5 and 6 of Erme; These files type are provided by operating system which ultimately owns all the file type).

Regarding dependent claims 30 and 31, they are rejected with the same rationale as claim 29. Supra.

Regarding claim 32, see the analysis of claim 13 above. Rosenzweig further teaches one or more medium stack icon comprises a second largest stack icon and wherein said second smallest stack comprises a third largest stack icon. (see Rosenzwig col.3, lines 45-lines 65)

***Response to Arguments***

Applicant's arguments with respect to claims 1-3, 5, 6-15, and 18-32 have been considered but are moot in view of the new ground(s) of rejection.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SIMON KE whose telephone number is (571)272-4062. The examiner can normally be reached on M-Th and Alternate Fridays 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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